



Docket No.: 273117US0PCT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

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RE: Application Serial No.: 10/542,358

Applicants: Yasuaki YOKOYAMA, et al.

Filing Date: July 14, 2005

For: COMPOSITION FOR FORMING SILICON-
ALUMINUM FILM, SILICON-ALUMINUM FILM
AND METHOD FOR FORMING THE SAME

SIR:

Attached hereto for filing are the following papers:

**Renewed Request for Status under 37 C.F.R. §1.42; Copy of Decision;
Certification of Translation; Copy of Declaration (as previously filed on
July 14, 2005); & Copy of Date-Stamped Filing Receipt**

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Corwin P. Umbach, Ph.D.
Registration No. 40,211

Customer Number

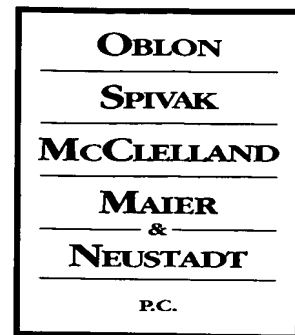
22850

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DOCKET NO: 273117US

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
YASUAKI YOKOYAMA, ET AL. : EXAMINER:
SERIAL NO: 10/542,358 :
FILED: JULY 14, 2005 : GROUP ART UNIT:
FOR: COMPOSITION FOR FORMING :
SILICON-ALUMINUM FILM, SILICON-
ALUMINUM FILM AND METHOD FOR
FORMING THE SAME

RENEWED REQUEST FOR STATUS UNDER 37 C.F.R. § 1.42

MAIL STOP PCT
COMMISSIONER FOR PATENTS
OFFICE OF PCT LEGAL ADMINISTRATION
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450

SIR:

In response to the Decision dated May 30, 2006 (copy attached), which indicates that the papers filed July 14, 2005, are being treated as a request for status under 37 C.F.R. § 1.42, attached is a statement that the translation contained in the Declaration filed July 14, 2005 (copy attached), is accurate. Applicants respectfully request that the above-identified application be granted status under 37 C.F.R. § 1.42.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

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UNITED STATES PATENT AND TRADEMARK OFFICE



30 MAY 2006

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ALEXANDRIA, VA 22314

273117452P0

In re Application of YOKOYAMA et al

U.S. Application No.: 10/542,358

PCT Application No.: PCT/JP03/16579

Int. Filing Date: 24 December 2003

Priority Date Claimed: 17 January 2003

Attorney Docket No.: 273117US0PCT

For: COMPOSITION FOR FORMING

SILICON-ALUMINUM FILM. . .

RECEIVED: 6/30/06 DECISION
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.

DOCKETING DEPT.

Initials/Date Docketed: 19/06/06

Type of Resp(s): Renewed Request Status of 1.42

Due Date(s): 7/30/06

This is in response to the papers filed 14 July 2005, which is being treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 24 December 2003, applicant filed international application PCT/JP03/16579, which claimed priority of an earlier Japan application filed 17 January 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 05 August 2004. The thirty-month period for paying the basic national fee in the United States expired on 17 July 2005.

On 14 July 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and an executed declaration.

DISCUSSION

The declaration filed 14 July 2005 states that joint inventor Yasuaki Yokoyama is deceased.

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent."

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

In the present case, the declaration meets the requirements of 37 CFR 1.497(b)(2). However, the declaration does not satisfy 37 CFR 1.69(b).

37 CFR 1.69(b) states,

Unless the text of any oath or declaration in a language other than English is in a form provided by the Patent and Trademark Office or in accordance with PCT Rule 4.17(iv), it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

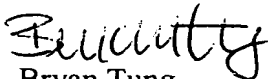
The declaration is not in a form provided by the USPTO, i.e. USPTO Form PTO/SB/103. Applicant must submit either: (1) a declaration using USPTO Form PTO/SB/103 or (2) a statement that the translation contained in the submitted declaration is accurate.

CONCLUSION

For the reasons above, the request for status under 37 CFR 1.42 is DISMISSED without prejudice.

If reconsideration on the merits of the request is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Request for Status Under 37 CFR 1.42".

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

CERTIFICATION

I, Fumiko Matsui, am familiar with the Japanese and English languages.

I have reviewed the attached Declaration For Patent Application Japanese Language Declaration, which was submitted to the U.S. Patent Office on July 14, 2005. The translation contained in the submitted declaration is accurate.


Fumiko Matsui

June 14, 2006
Date



Due Date July 17, 2005

OSMM&N File No. 273117US0PCT

By NFO/ky/FF

Serial No. New U.S. PCT Application based on PCT/JP03/16579

In the matter of the Application of Yasuaki YOKOYAMA, et al.

For COMPOSITION FOR FORMING SILICON-ALUMINUM FILM, SILICON-ALUMINUM FILM AND METHOD FOR FORMING THE SAME

The following has been received in the U.S. Patent Office on the date stamped hereon:

- 31 pgs. Specification 2 Claims (English Translation)
- Declaration (3 pages)
- Application Data Sheet (2 pages)
- Notice of Priority
- Dep. Acct. Order Form
- Credit Card Payment Form for \$900.00
- Drawing (1 sheet)
- PCT Transmittal Letter
- Preliminary Amendment
- PCT/IB/304
- Information Disclosure Statement
- Cited References (1)
- International Search Report
- Statement under 37 CFR 3.73(b) (with attached copy of Assignment)
- General Power of Attorney

■ PCT/IB/308

■ PTO-1449



SERIAL NO. _____

DATE RECEIVED _____



Declaration For Patent Application

特許出願宣言書

Japanese Language Declaration

日本語宣言書

下記の氏名の発明者として、私は以下の通り宣言します。

下記の名称の発明に関して請求範囲に記載され、特許出願している発明内容について、私が最初かつ唯一の発明者（下記の氏名が一つの場合）もしくは最初かつ共同発明者（下記の名称が複数の場合）であると信じています。

上記発明の明細書は、

☐ 本書に添付されています。

☐ _____ 月 _____ 日に提出され、米国出願番号または特

許協定条約国際出願番号を

_____ とし、

(該当する場合) _____ に訂正されました。

私は、特許請求範囲を含む上記訂正後の明細書を検討し、内容を理解していることをここに表明します。

私は、連邦規則法典第 37 編第 1 条 56 項に定義されるとおり、特許資格の有無について重要な情報を開示する義務があることを認めます。継続願書一部分を含む資料案内は前回の願書記入日から、米国願書または国際特許協定条約継続願書記入日の間に入手できます。

As a below-named inventor, I hereby declare that:

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled.

COMPOSITION FOR FORMING SILICON-ALUMINUM FILM, SILICON-ALUMINUM FILM AND METHOD FOR FORMING THE SAME

the specification of which

☐ is attached hereto.

☒ was filed on December 24, 2003

as United States Application Number or PCT International Application Number

PCT/JP03/16579 and was amended on

_____ (if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.

私は、私自身の知識に基づいて本宣言書中で私が行なう表明が真実であり、かつ私の入手した情報と私の信じることに基づく表明が全て真実であると信じていること、さらに故意になされた虚偽の表明及びそれと同等の行為は米国法典第18編第1001条に基づき、罰金または拘禁、もしくはその両方により処罰されること、そしてそのような故意による虚偽の声明を行なえば、出願した、又は既に許可された特許の有効性が失われることを認識し、よってここに上記のごとく宣誓を致します。

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

単独発明者または第1の共同発明者の氏名	Full name of sole or first inventor Yasuaki YOKOYAMA (deceased)
国籍	Citizenship of First Joint Inventor JAPAN
発明者の署名 日付	<p>Inventor's signature:</p> <p>Legal Representative of first joint inventor</p> <p>We, Michiko YOKOYAMA, Naomi SHINODA, and Risa YOKOYAMA, are the heirs and legal representative of Yasuaki YOKOYAMA (deceased). We attest, upon information and belief, that the aforementioned facts are true.</p> <p>Signature of Michiko YOKOYAMA <u>Michiko Yokoyama</u> Residence of Michiko YOKOYAMA: Mie, JAPAN Citizenship of Michiko YOKOYAMA: JAPAN Mailing Address of Michiko YOKOYAMA: 35-15, Oukadai 2-chome, Yokkaichi-shi, Mie, JAPAN</p> <p>Signature of Naomi SHINODA <u>Naomi Shinoda</u> Residence of Naomi SHINODA: Aichi, JAPAN Citizenship of Naomi SHINODA: JAPAN Mailing Address of Naomi SHINODA: Kaniehommachi Tanowari 8-3, Kanie-cho, Ama-gun, Aichi, JAPAN</p> <p>Signature of Risa YOKOYAMA <u>Risa Yokoyama</u> Residence of Risa YOKOYAMA: Mie, JAPAN Citizenship of Risa YOKOYAMA: JAPAN Mailing Address of Risa YOKOYAMA: 35-15, Oukadai 2-chome, Yokkaichi-shi, Mie, JAPAN</p> <p>Date <u>June 18, 2005</u></p> <p>Date <u>June 19, 2005</u></p> <p>Date <u>June 18, 2005</u></p>

第 2の共同発明者の氏名	Full name of second joint inventor, if any Yasuo MATSUKI	
第 2の共同発明者の署名	日付	Second inventor's signature Date <i>Yasuo Matsuki</i> June 14, 2005
住所	Residence Chuo-ku, Tokyo, JAPAN	
国籍	Citizenship JAPAN	
郵便の宛先	Mailing Address c/o JSR Corporation, 6-10, Tsukiji 5-chome, Chuo-ku, Tokyo 104-0045 JAPAN	